

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the specification

The specification is amended, as shown in the foregoing AMENDMENT TO THE SPECIFICATION, to correct minor informalities to comply with U.S. practices. No new matter is added, as the changes simply correct minor informalities.

Entry of the AMENDMENT TO THE SPECIFICATION is respectfully requested in the next Office communication.

2. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

A. Claim Amendments

Claim 1 is amended to recite a method of using an electronic intermediate carrier configured to perform cashless processing. This method is performed by, at a first time (t1), receiving a data record assigned to the service from an owner's personal electronic payment device, directly or indirectly by a personal electronic device of the owner. Then at a second time (t2), checking the data record or data derived therefrom in the electronic intermediate carrier by a receiving device of the payee as to whether the service was rendered correctly, and deleting or invalidating the data record completely or with regard to the data derived therefrom in the electronic intermediate carrier if the service was rendered correctly, wherein the electronic intermediate carrier is formed as a transferable unit physically separate from the owner's personal electronic payment device. It is respectfully submitted that no new matter is added, since the changes merely merge the subject matter of previously presented claims, and since support for the amendments may

be found, for example, at least in paragraphs [0012], [0022] and [0023] of the accompanying description in the specification as originally filed.

Claim 5 is amended to recite encrypting the data record with a public key. No new matter is added, since support for the amendment may be found, for example, at least in paragraph [0011] of the specification.

Claim 6 is amended to recite that the data record depends on the personal data of the owner of the personal electronic payment device. No new matter is added, since support for the amendment may be found, for example, at least in claim 6 as originally filed, and, for example, at least in paragraph [0011] of the specification.

Claim 9 is amended to recite that the electronic intermediate carrier is not in the possession of the owner of the personal electronic payment device. No new matter is added, since support for the amendment may be found, for example, at least in claim 9 as originally filed, and, for example, at least in paragraph [0012] of the specification.

Claim 16 is amended to clarify and recite transmitting, from the intermediate carrier to the personal electronic payment device, data on the functionality required for transmitting a data record from the personal electronic payment device or a personal device to the intermediate carrier. No new matter is added, since the amendment more clearly defines the subject matter of the claims, and support for the amendment may be found, for example, at least in claim 16 as originally filed.

Claim 17 is amended to recite a personal electronic payment device and that the receiving device is arranged to check the data record as to whether it tenders the service correctly and to invalidate or delete the data record completely or with regard to the data derived therefrom, if the service was rendered correctly, so as to prevent the data carrier from being used several times for payment transactions. It is respectfully submitted that no new matter is added, since support for the amendments may be found, for example, at least in claims 1 and 8 as originally filed and, for example, at least in paragraphs [0012],

[0022] and [0023] of the accompanying description in the specification as originally filed.

Claim 23 is amended to recite the personal electronic means of payment of an owner is a mobile telephone. It is respectfully submitted that no new matter is added, since this amendment is made to provide proper antecedent basis and support for the amendment may be found, for example, at least in claim 23, and, for example, at least in paragraph [0015] of the accompanying description in the specification.

Claim 24 is amended to be consistent with amended claim 17. It is respectfully submitted that no new matter is added, since the change merely provides consistency between the claims.

Claims 2-4, 7, 10-15, 18-22, and 25 are left unchanged.

Claim 8 has been canceled and the subject matter thereof added to amended claim 1.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

B. Rejection of claims 1-25 under 35 U.S.C. § 101 as being directed to non-statutory subject matter

Reconsideration of this rejection is respectfully requested, in view of the amendments to claims 1 and 17, on the basis that the claims as currently amended recite statutory subject matter.

The Office action is correct in asserting, on page 4 of the action dated June 9, 2010, that one possible test in determining patent eligible subject matter is whether or not the process is tied to a particular machine or transforms a particular article to a different state or thing. It is respectfully submitted that both claims 1 and 17 recite particular machines.

Amended claim 1 recites a method of using an electronic intermediate carrier configured to perform cashless processing of a transaction for paying for a service, which positively recites to a method tied to a machine. Since the machine as recited in amended claim 1 implements the steps of the method, claim 1 recites to statutory subject matter.

Furthermore, claim 17 recites a system having multiple machines configured to transmit a data record and the receiving device is arranged to check the data record as to whether it renders the service correctly and to invalidate or delete the data record completely or with regard to the data derived therefrom. Similar to the argument with respect to claim 1, since the system as recited in claim 17 has multiple particular machines tied to the process as recited in claim 17, amended claim 17 recites to statutory subject matter.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2-16 and 18-25 depend on claims 1 and 17, respectively; therefore these claims are also considered to contain patentable subject matter since they contain all of the features of claims 1 and 17.

C. Rejection of claims 16 and 23 under 35 U.S.C. § 112, second paragraph

Reconsideration of this rejection is respectfully requested in view of the amendments with respect to claims 16 and 23, on the basis that the claims as amended particularly point out the subject matter of the claims. Claim 16 now recites “transmitting from the intermediate carrier to the personal electronic payment device data,” which points out what is being claimed. Additionally, claim 23 is amended to recite “the personal electronic payment device” to provide proper antecedent basis.

Accordingly, withdrawal of this rejection is respectfully requested.

3. Rejection of claims 1-8, 10, and 14-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No 5,602,919 (*Hurta*) in view of Official Notice

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claims 1 and 17, from which claims 2-8, 10, 14-16, and 18-25 respectively depend.

Claim 1 recites, among other inventive features, a method of using an electronic intermediate carrier configured to perform cashless processing of a transaction for paying for a service between an owner of a personal electronic payment device and a payee. This method is performed by, at a first time (t1), receiving a data record assigned to the service from an owner's personal electronic payment device. Then at a second time (t2), checking the data record in the electronic intermediate carrier by a receiving device of the payee as to whether the service was rendered correctly, and deleting or invalidating the data record completely or with regard to the data derived therefrom in the electronic intermediate carrier if the service was rendered correctly, so as to prevent the data record from being used several times.

It is submitted that this method allows a payee to receive, in an intermediate carrier, a data record from an owner of a personal electronic payment device so that the electronic intermediate carrier can make a cashless payment at a latter time by checking the data (paragraph [0012], [0022]). After this data is checked to determine if it is suitable for effecting the intended payment transaction and once the service has been rendered correctly, the electronic intermediate carrier then deletes or invalidates the data record to prevent the data record from being used several times for payment transactions (paragraphs [0009], [0012]).

It is respectfully submitted that the *Hurta* patent does not teach or disclose receiving in an intermediate carrier a data record from an owner's personal electronic payment device, where at a second time the data record is checked as to whether the

service was rendered correctly; and then deleting or invalidating the data record, as required by amended claim 1.

At most the *Hurta* patent discloses transmitting a signal from a smart card transponder to an interrogator to transfer money from the smart card to the interrogator (column 2, lines 23-33 and column 2, lines 59-64). The transponder is designed to allow fast transactions with an interrogator of a road pricing system (column 2, lines 23-33). The interrogator initiates this request by sending an approach message to alert the transponder (column 6, lines 3-7). Then the transponder informs the interrogator of its identity, authorization codes, and similar information (column 6, lines 10-18).

However, it is respectfully submitted, that the *Hurta* patent does not disclose deleting or invalidating the data record after it has been checked as to whether the service was rendered correctly. Even assuming, but not admitting, that the identity and other information is a data record, the *Hurta* patent fails to disclose deleting or invalidating the data record after the transaction has taken place. Rather, the *Hurta* patent discloses processing the code and determining if the code matches and merely subtracting from the running total of value units stored in the transponder memory (column 6, lines 35-39). It is respectfully submitted that this subtraction of a running total is a different feature than receiving a data record and after checking the record, deleting or invalidating the data record rather than manipulating some other associated value.

Additionally, the Office action dated June 9, 2010 on page 10 suggests that the *Hurta* patent discloses deleting or invalidating the data record by the disclosure of the feature that a transaction response will either be the transponder certificate or an error code explaining why a transponder certificate could not be generated and the transaction failed.

However, it is respectfully submitted that one having ordinary skill in the art would find a failed transaction to be a different feature than the feature as recited in amended claim 1. Amended claim 1 recites to deleting or invalidating the data record after

the service has been rendered correctly. This allows the protection of the data record after use, so as to prevent the data record from being used several times for payment transactions. Whereas the *Hurta* patent only discloses checking the data record to issue a transponder certificate or an error code denying the transaction from taking place.

Accordingly, a *prima facie* case of obviousness cannot be established with respect to amended claim 1, since the *Hurta* patent at least fails to disclose deleting or invalidating the data record. Therefore, withdrawal of this rejection is respectfully requested.

Claim 17 recites similar structural features as are recited in amended claim 1, as well as its own recited features. Therefore, a *prima facie* case of obviousness cannot be established with respect to amended claim 17, since the *Hurta* patent at least fails to disclose deleting or invalidating the data record.

It is submitted since independent claims 1 and 17 are considered to be patentable, claims 2-8, 10, 14-16 and 18-25, which depend from claims 1 and 17 respectively, are also considered to be patentable as containing all of the steps or elements of claims 1 and 17, as well as for their respective recited features.

4. Rejection of claims 9 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,602,919 (*Hurta*) in view of Official Notice and further in view of U.S. Pat. No. 6,013,949 (*Tuttle*)

Reconsideration of this rejection is respectfully requested, in view of the amendments to claim 1, from which claims 9 and 11-13 depend, on the basis that the *Tuttle* patent fails to provide for the deficiencies of the *Hurta* patent.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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